

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
BERT W. ELLIOTT ) Group Art Unit: 3635  
                      )  
Serial No.: 09/515,928 ) Examiner: Ryan D. Kwiecinski  
                      )  
Filed: February 29, 2000 ) Confirmation No.: 1357  
                      )  
For: SHINGLE FOR OPTICALLY ) Attorney Docket: 24673A  
                      SIMULATING A SLATE ROOF )

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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41 and § 41.43

Honorable Sir:

This reply brief is in response to the Examiner's Answer dated June 18, 2008.

Any necessary fees are to be charged to Deposit Account No. 50-0568.

Appellant accordingly requests that the Board of Patent Appeals and  
Interferences reverse the Examiner as to all rejections.

Respectfully submitted,



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### I. Status of Claims

Claims 17, 46-48, 53-58, 65-68 and 70 are finally rejected. Claims 1-16, 18-45, 49-52, 59-64, 69 and 71-73 are cancelled. Claims 17, 46-48, 53-58, 65-68 and 70 are appealed.

### II. Grounds of Rejection to be Reviewed on Appeal

Grounds of rejection are set forth in the Advisory Action dated July 19, 2007 and the final Office Action dated September 19, 2007, as:

- A. Whether claims 67 and 68 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent 6,014,847 to Phillips (hereafter, "Phillips") in view of U.S. Patent 1,843,370 to Overbury (hereafter, "Overbury").
- B. Whether claims 17, 46-48, 53-58, 65-68 and 70 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent 5,195,290 to Hulett (hereafter, "Hulett") in view of U.S. Patent 1,843,370 to Overbury (hereafter, "Overbury").
- C. Whether claims 17, 46-48, 53-58, 65-68 and 70 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent 5,939,169 to Bondoc (hereafter, "Bondoc") in view of U.S. Patent 1,843,370 to Overbury (hereafter, "Overbury").

### III. Argument

A. Rejection of claims 67 and 68 under 35 U.S.C. 103(a) over Phillips in view of Overbury.

1. Omission of the limiting phrase "now and then". The Examiner argued, on page 4 of the Examiner's Answer dated June 18, 2008, that "Overbury further provides that if desired two or more tabs may be given the same color". Applicant asserts the omission of the language "now and then" from this statement is a mischaracterization of the Overbury reference. Quoting the precise language of the Overbury reference on page 2 at lines 94-96, "although if desired two or more adjacent tabs may now and then be given the same color". As discussed in Applicant's Appeal

Brief on page 12, the phrase “now and then” is a significant limiting factor in the Overbury reference that limits the occurrence of multiple tabs of the same color in the same shingle to occasional occurrences, occurring seldomly. Therefore, as noted by the Declaration of Mr. Elliott filed July 27, 2006, the resulting roof of Overbury would not have a predominant color and would not have the appearance of a natural slate roof.

2. Specification provides support for problem solved by the particular claimed percentiles. The Examiner stated on page 5 of the Examiner’s Answer dated June 18, 2008, that Applicant’s specification fails to teach any problem in the art solved by the particular percentiles claimed. Applicant respectfully traverses this statement.

Applicant’s specification, on page 2 at lines 5-10, provides that natural slate roofs typically have a predominant color, such as gray, with one or more additional accent colors interspersed to add variety. An example of a common mix of colors for a slate roof might include roughly 60 percent of the tiles having a light gray background color, about 15 percent of the tiles having a purple color, and about 25 percent of the tiles having a dark gray color. Accordingly, Applicant’s claims 46, 56 and 68 claim a predominant tab color blend that occurs in roughly 60 percent of the tabs, which is sufficiently prevalent to provide a roof covering with an appearance that simulates a natural slate roof.

3. Crushed slate has a different appearance than a natural slate roof. The Examiner argued on page 9 of the Examiner’s Answer dated June 18, 2008 that crushed slate will have the appearance of a natural slate roof. Applicant asserts crushed slate will have a different appearance than a roof covering with an appearance that simulates a natural slate roof. As provided on page 7 of Applicant’s Appeal Brief, a natural slate roof has the appearance of individual slate tiles having a predominant color mixed with other tiles having an accent color.

4. Nexus between the claimed invention and the commercial success. On page 11 of the Examiner’s answer dated June 18, 2008, the Examiner, citing the case of

Cable Electric Products, Inc. v Genmark, Inc., asserted Applicant failed to provide a nexus between the claimed invention and the alleged commercial success as the gross sales figures do not show commercial success absent evidence as to market share. Applicant asserts the evidence provided in Applicant's secondary considerations distinguishes Applicant's case from the Cable Electric Products case. Applicant has provided evidence, on page 3 of the Elliott Declaration, of first year sales in 2003 of \$3,000,000. Since this was a new product to the roofing market and there were no competitors offering a similar product, the first year sales would have constituted a market share of 100%. As noted on page 4 of the Elliott Declaration, a first competitor began offering a copy of the simulated slate roofing product approximately 16 months after the introduction of Applicant's simulated slate roofing product. Accordingly, Applicant's evidence of secondary considerations, namely the gross sales in a new market and the subsequent copying by a competitor, provide a strong nexus between the claimed invention and the alleged commercial success.

B. Rejection of claims 17, 46-48, 53-58, 65-68 and 70 under 35 U.S.C. 103(a) over Hulett in view of Overbury.

1. Omission of the limiting phrase “now and then”. The Examiner argued, on page 6 of the Examiner's Answer dated June 18, 2008, that “Overbury further provides that if desired two or more tabs may be given the same color”. For the same reasons as discussed above, Applicant asserts the omission of the language “now and then” from this statement is a mischaracterization of the Overbury reference.

2. Specification provides support for problem solved by particular claimed percentiles. The Examiner stated on page 7 of the Examiner's Answer dated June 18, 2008, that Applicant's specification fails to teach any problem in the art solved by the particular percentiles claimed. For the same reasons as discussed above, Applicant respectfully traverses this statement.

C. Rejection of claims 17, 46-48, 53-58, 65-68 and 70 under 35 U.S.C. 103(a) over Bondec in view of Overbury.

1. Omission of the limiting phrase “now and then”. The Examiner argued, on page 8 of the Examiner’s Answer dated June 18, 2008, that “Overbury further provides that if desired two or more tabs may be given the same color”. For the same reasons as discussed above, Applicant asserts the omission of the language “now and then” from this statement is a mischaracterization of the Overbury reference.

2. Specification provides support for problem solved by particular claimed percentiles. The Examiner stated on page 9 of the Examiner’s Answer dated June 18, 2008, that Applicant’s specification fails to teach any problem in the art solved by the particular percentiles claimed. For the same reasons as discussed above, Applicant respectfully traverses this statement.